

BEST AVAILABLE COPY**Remarks****Status of the Claims**

Claims 1-36 are pending in the application. All claims stand rejected. By this paper, claims 1, 5, 7, 9, 10, 15, 17, 19, 22, 24, 26-33 have been amended. Claim 23 has been canceled without prejudice. Reconsideration of all pending claims herein in view of the amendments and following remarks is respectfully requested.

Support for Claim Amendments

Claim 1 was amended to read, in pertinent part, "triggering notification of the identified specific merchant to allow the specific merchant to initiate communication with the customer." Support for this amendment can be found in Figure 5, as well as paragraphs [0058]-[0060] of the published application. Claim 15 was amended to include the same limitation.

Claim 5 was amended to read "[t]he method of claim 1, further comprising correlating a characteristic associated with the interactive advertisement to the merchant information to enable identification of the specific merchant based on the detected response." Support for this amendment can be found at least in the Summary of the Invention, paragraph [0009], and also in paragraph [0080]. Claim 17 was amended to include the same limitation.

Claim 7 was amended to read "[t]he method of claim 1 wherein the communication between the specific merchant and the customer is conductable via video conferencing." Support for this amendment can be found at least in

paragraphs [0063] and [0064]. Claim 22 was amended to include the same limitation, for which further support can be found in paragraph [0078].

Claim 9 was amended to read, in pertinent part, "sending the completed pre-order template to the identified specific merchant prior to an actual order being sent." Support for this amendment can be found in paragraphs [0058] and [0061]. The pre-order template provides customer information, including contact information with which to contact the customer to complete a sale. Claims 19 and 24 were amended to include the same limitation.

Claim 26 was amended to read "[t]he system of claim 22, further comprising video equipment at both the customer's location and the merchant's location to facilitate video conferencing to approximate a face-to-face transaction when the response is detected." The "conferencing" amendment is the same as in claims 7 and 22, but for a system claim; thus, support for this amendment can also be found in paragraphs [0063] and [0064]. Support for the remaining amendment can further be found at least in paragraphs [0064] and [0071]-[0074].

The remainder of the amendments were to add the word "merchant-" before the words "preferred method," in conjunction with a merchant's registration of a preferred method of different forms of communication between the merchant and the customer. Support for this amendment can be found at least in paragraphs [0033] and [0053].

Claim Rejections

Claims 1-12, 14-21, and 34-36 were rejected under 35 U.S.C. 103(a) as being unpatentable over Levitan in view of Toader and Kikinis. Claims 22-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Levitan in view of Toader. Claims 13 and 27-33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Levitan in view of Toader and Kikinis and further in view of McCollum et al. ("McCollum"). For the reasons set forth below, these rejections are respectfully traversed.

1. **Cited References Do Not Disclose Notifying a Specific Merchant to Allow the Merchant to Initiate Communication With a Customer as Recited in Claims 1 and 15**

Claims 1 and 15 have been amended to clarify that the merchant contacts the customer after being notified of the customer's interest. For example, as shown in FIG. 5, after the customer is identified and the advertisement is correlated with a specific merchant (510), the merchant is notified (512) and the merchant is connected with the customer (514). Likewise, the specification states that after "the activation of the indicator 404 is detected by the advertising service, the customer is identified, customer information is correlated with the particular interactive advertisement 402 and/or with its corresponding merchant, the corresponding merchant (such as a local affiliate merchant of the airline company that sells the advertised tickets) is notified by the advertising service, and then the merchant communicates with the customer to fulfill the response. Application at page 18.

Notifying the merchant and allowing the merchant to initiate communication with the customer is advantageous because the customer, after expressing interest in an advertisement, may become distracted and not follow through with a purchase. In the claimed invention, the party typically most interested in completing a transaction (*i.e.*, the merchant) is notified and allowed to follow up with the customer at a later time. Thus, even if the customer becomes distracted or temporarily loses interest, a transaction may still be completed.

In this respect, Levitan is the exact opposite of the claimed invention. According to Levitan, if the "recipient decides to buy the product, he clicks on 'Compose order.' The e-mail order will appear on the screen overlaying the advertisement." Col. 7, lines 28-31. In other words, Levitan helps a customer compose an e-mail to a merchant for ordering a product. Thus, Levitan's customer is initiating contact with the merchant, and not the other way around, as claimed. The Examiner apparently concurs, stating in the Office Action:

it is noted that since the user can communicate directly with the advertisers and compose ... orders for products from the advertisers, Levitan discloses ... triggering notification of the identified specific advertiser to allow communication between the user and the specific advertiser."

Office Action, pages 2-3. Because this is the opposite of merchant-initiated communication, Levitan actually teaches away from the claimed invention.

None of the other cited references teach or suggest that the merchant initiates contact with a customer after the customer presses a "Buy" button or the like while viewing the interactive advertisement within a broadcast segment. For example, Toader teaches that the user must first send written queries to the sponsor's staff, which is equivalent to Levitan's customer-initiated communication. Col. 4, lines 52-

53. Kikinis has nothing to do with initiating communication between the merchant and the customer.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03. Because none of the cited references teach or suggest that the merchant initiates contact with a customer, the applicant respectfully submits that a *prima facie* case of obviousness cannot be established with the cited references. Accordingly, claim 1, as amended, is patentably distinct. Claim 15 has been amended to include similar limitations and is likewise believed to be patentably distinct.

2. Cited References Do Not Disclose Notifying a Merchant When a Customer Responds to an Advertisement While Watching an Advertisement Within a Broadcast Segment as Recited in Claims 1 and 15

As noted by the Examiner, "Levitan discloses a method ... for linking a customer to a merchant ... after viewing [an] advertisement." Office Action, page 2 (emphasis added). There is no teaching or suggestion that Levitan's users can respond while watching one of his commercials-on-demand (COD), let alone have a merchant notified as a result of the response.

Likewise, Toader does not notify a merchant when a customer responds to an advertisement while watching a broadcast segment. Toader merely discloses an Internet entry server for hot-linking the customer to a sponsor's Web page. The reference says nothing about a broadcast segment or an interactive advertisement within a broadcast segment.

The Office Action apparently agrees with the foregoing, stating that the "combination of Levitan and Toader fails to teach the claimed [limitation of] while the customer is viewing the interactive advertisement ... within a broadcast segment." Office Action, page 4. However, contrary to the Examiner's assertions, Kikinis does not cure the deficiencies of Levitan and Toader.

While Kikinis arguably teaches interactive advertisements within a broadcast segment, Kikinis says nothing about notifying a merchant when a customer responds to an advertisement while watching a broadcast segment. Kikinis displays, for example, a BMW advertisement based on a URL sent during a television program. While one of Kikinis' users can arguably interact with the advertisement, there is no teaching or suggestion of notifying a merchant of the interaction. For example, if the user browses the www.bmw.com home page, there is no teaching or suggestion that a BMW merchant is notified, much less that the merchant initiates communication with the user, as recited in claim 1.

Because none of the cited references teach or suggest notifying a merchant when a customer responds to an advertisement *while* watching an advertisement within a broadcast segment, the applicant respectfully submits that a *prima facie* case of obviousness cannot be established with the cited references.

3. Cited References Do Not Disclose Claimed Correlation of a Characteristic of the Interactive Advertisement to the Merchant Information as Recited in Claims 5 and 6

With regard to claims 5 and 6, the Examiner states that "the combination of Levitan, Toader, and Kikinis fails to disclose correlating a characteristic associated

with the interactive advertisement to the merchant information, wherein the characteristic ... comprises one of a channel in which the interactive advertisement was provided, a time in which the interactive advertisement was provided, or a time in which the customer responded to the interactive advertisement." Office Action, page 4. However, the Examiner goes on to take Official Notice that it would have been well known to correlate the channel in which the advertisement was watched with an address to provide important statistical or marketing information to [an] advertiser or vendor." Office Action, page 5.

Claim 5 has been amended to clarify that the characteristic is correlated with the merchant information "to enable identification of the specific merchant based on the detected response." Thus, information about the channel being broadcast when the customer response was detected may be used to identify the merchant, as recited in claim 6. Likewise, the time in which the interactive advertisement was provided, or a time in which the customer responded to the interactive advertisement, may be used for a similar purpose.

As the Examiner observed, the cited references do not correlate such characteristics with the merchant information, let alone correlate such characteristics for purposes of enabling identification of the specific merchant base on the detected response. Levitan, for example, has no need to correlate a channel with the merchant information, since he embeds a URL in the broadcast, which is used to display an advertisement on the television.

The applicant respectfully traverses the Examiner's Official Notice of correlating a channel in which an advertisement is being watched with merchant

information for purpose of identifying a merchant based on a detected response, and respectfully requests that the Examiner provide a reference in support of the rejection.

4. Cited References Do Not Disclose Video Conferencing Between the Customer and the Specific Merchant as Recited in Claims 7, 22, and 26

Prior to the current amendments, Claim 7 recited that the communication between the specific merchant and the customer is conductable via video communication. Likewise, claim 22 recited a communication device communicatively coupled to the server to automatically initiate video communication between the customer and the specific merchant when the response is detected. Finally, claim 26 recited that both the customer's and the merchant's systems include video equipment to facilitate video communication, which approximates a face-to-face transaction.

To allegedly satisfy this limitation, the Examiner pointed out that Levitan "discloses a video clip." However, a video clip is not the same as video communication. A DVD could be referred to as a "video clip," but would certainly not be referred to as "video communication" by one of ordinary skill in the art. Levitan does not disclose or suggest any mechanism for placing the customer in video communication with the merchant in order to approximate a face-to-face transaction. None of the cited references disclose video equipment at the customer's and merchant's locations to facilitate video communication within any reasonable meaning of the term. Levitan merely allows a user to watch a commercial-on-demand (COD) by selecting a desired product category. One of ordinary skill in the

art would not refer to a user selection of a menu option as "video communication" between the customer and the merchant.

Although the applicant believes that the prior claim language distinguishes over the art of record, to advance prosecution of the application, the applicant has amended claims 7, 22, and 26 to recite "video conferencing" rather than "video communication." No one of ordinary skill in the art would refer to Levitan's "video clip" as video conferencing. Likewise, Toader does not disclose or suggest "video conferencing," but rather refers to text-based communication, such as e-mail. Finally, Kikinis does not teach or suggest establishing a video conferencing between a customer and a specific merchant when detecting a response to an interactive advertisement while the customer is viewing the interactive advertisement within a broadcast segment.

Even if one or more of the cited references taught video conferencing between the customer and a merchant, none of the cited references teach or suggest automatically initiating video conferencing between the customer and the specific merchant when the response is detected, as required in claim 22.

Because none of the cited references teach or suggest establishing a video conference between the customer and the merchant, the applicant respectfully submits that a *prima facie* case of obviousness cannot be established with the cited references. Accordingly, claims 7, 22, and 26 are patentably distinct.

5. Cited References Do Not Disclose Pre-Order Templates Sent Prior to An Actual Order as Recited in Claims 9, 19, and 24

As amended, claims 9, 19, and 24 recite the customer completes a pre-order template including at least some of the identified customer information and the merchant information, and that the completed pre-order template is sent to the identified specific merchant prior to an actual order being sent. The pre-order template provides some valuable information to a merchant to assist the merchant when contacting the customer, as described above. It also allows the merchant to have certain information already "entered" in order to accelerate the process of generating an actual order once the merchant initiates contact with the customer. The pre-order template is not an order, it is information sent to the merchant in advance of an order. Otherwise, the prefix "pre-" would have no meaning.

To allegedly satisfy this limitation, the Office Action cites to a portion of Levitan as follows:

At recipient's request, the system automatically composes an order using recipient's name and address included in recipient's data and advertiser's e-mail address brought by commercial, and sends the order through the Internet to advertiser.

Co. 3, lines 31-35 (emphasis added).

Based on the foregoing, what Levitan composes is clearly an "order" as opposed to a "pre-order" template. An order cannot logically be referred to as a "pre-order." Furthermore, Levitan does not send the pre-order template to the identified specific merchant prior to an actual order being sent, as claimed. What Levitan sends through the Internet to the advertiser is, in fact, an order. None of the other references disclose or suggest anything remotely similar to the claimed pre-order

template, which is used for facilitating communication between the merchant and the seller, and is conceptually separate from the order, itself.

6. Cited References Do Not Disclose Claimed Techniques for Triggering Notification of the Merchant as Recited in Claim 10

As amended, claim 10 recites:

wherein triggering notification of the identified specific merchant comprises sending one of a telephone message, voicemail message, page message, instant message, facsimile message, or wireless device message to the specific merchant to notify the specific merchant to contact the customer.

The applicant respectfully submits that none of the cited references, alone or in combination, teach or suggest one of the foregoing methods for notifying the merchant. Accordingly, a *prima facie* case of obviousness cannot be established with the cited references.

7. Toader and Levitan Fail to Teach or Suggest Video Communication, Let Alone Video Conferencing as recited in Claim 22

Claims 22-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Levitan in view of Toader. However, the rejection on pages 8 and 9 of the Office Action completely fails to mention the claimed "video communication," let alone a "communication device ... to automatically initiate video communication." With regard to claim 22, the Office Action states that "Levitan discloses ... triggering notification of the identified specific advertiser to allow communication between the user and specific advertiser." However, this paraphrased language is taken from the original claim language, not the amended claim language presented in the applicant's

response of February 17, 2005, and omits discussion of the newly added "video" language.

None of the cited references teach or suggestion automatically initiating video communication between a customer and a merchant. For example, Levitan is limited to e-mail orders, while Toader provides for text-based communication.

As noted above, although the applicant believes that the prior claim language distinguishes over the art of record, to advance prosecution of the application, the applicant has amended claims 22 to recite "video conferencing" rather than "video communication." Those of ordinary skill in the art understand that "video conferencing" is fundamentally different from Levitan's "video clips," which were cited with respect to claim 7. Levitan's video clips are commercials-on-demand (COD), which are displayed in response to a user selection of a particular category of merchandise. They do not in any way represent "video communication" between the merchant and the customer, much less video "conferencing." Video conferencing is understood in the art to mean "conducting a conference between two or more participants at different sites by using computer networks to transmit audio and video data." See <http://www.webopedia.com/TERM/v/videoconferencing.html>.

Because none of the cited references teach or suggest video conferencing, the applicant respectfully submits that a *prima facie* case of obviousness has not been established by Levitan and Toader.

8. Cited References Do Not Disclose Registering *Merchant-Preferred Methods* for Automatically Notifying the Merchant When the Customer Response is Detected as Recited in Claims 27-30

New claim 27 recites registering a merchant-preferred method for automatically notifying the merchant when the customer response is detected. McCollum does not disclose or suggest registering any method, preferred or otherwise, for automatically notifying the Merchant when a customer response is detected. As the Examiner stated in the prior Office Action, McCollum merely discloses the registration of contractual information, categories for commercials, etc.

Contrary to the present Office Action, Toader does not disclose registering a merchant-preferred method for automatically notifying the merchant. The portions of Toader referred to by the Examiner (*i.e.*, col. 2, lines 27-40 and col. 4, lines 45-58) relate to registering a customer's preferences, not the merchant's preferences, as claimed. Since it is the merchant that is to contact the customer (see above remarks with respect to claim 1), the customer's preferences about a notification method are irrelevant. According to the claimed invention, it is the merchant who is notified, not the customer. For example, Toader states that the "first time a customer uses the on-line help service, the Internet Entry Server performs a registration process which includes a number of personal questions...." Col, 2, lines 27-30.

Because the cited references do not disclose or suggest registering a merchant-preferred method for automatically notifying the merchant, the applicant respectfully submits that a *prima facie* case of obviousness cannot be established with the cited references.

Claim 28 recites registering a telephone number of the merchant that will be automatically called when the customer response is detected. The portion of Toader cited by the Examiner is as follows:

At block 3, the customer loads the Internet access software and initiates log-in. Log-in can be a requirement during the set-up phase of the purchased software, for example, such that registration is automatically accomplished. For example, during set-up the software can cause the customer's PC to automatically dial a toll free number to access the sponsor's domain and registration can be accomplished as described below for all customers.

Col. 4, lines 1-8 (emphasis added). As clearly shown in the above paragraph, the registration process is for the customer, not the merchant. Moreover, it is the customer's PC that initiates communication with the merchant, instead of the other way around, as required by claim 1.

Claim 29 recites registering a facsimile number of the merchant to which a facsimile will be automatically sent when the customer response is detected. The applicant respectfully traverses the Examiner's Official Notice of registering a preferred telephone or facsimile number of a merchant for purposes of automatically notifying the merchant when a customer response is detected. The mere existence of telephone and facsimile communication does not render obvious the claimed use of the technology in the context of the claimed invention. Automatic dialing of telephone calls or transmission of facsimiles in response to a user responding to an interactive advertisement while watching a broadcast segment is not well known in the art. In any case, neither the prior art nor the Examiner's Official Notice relates to merchant-preferred contact methods, which also applies to claim 30 relating to e-mail notification. Accordingly, the applicant respectfully requests that the Examiner provide a reference in support of the rejection.

9. Cited References Do Not Disclose Claimed Registration of Merchant-Preferred Categories of Customers from Which to Receive Responses

As amended, Claim 31 recites registering a merchant-preferred category of customers from which to receive responses. Levitan apparently receives responses from all types of customers, not a preferred category of customers, let alone a merchant-preferred category of customers. Likewise, none of the other cited references disclose or suggest registering a merchant-preferred category of customers from which to receive responses.

The Examiner cited to Toader as follows:

At block 4, the IES receives the protocol handshake automatically entered by the PC and verifies the customer's PIN number. At block 5, the IES prompts the customer with a customized "welcome" screen which preferably features the sponsor/vendor's logo and other sponsor/vendor supplied information. At this point, the customer is requested to register by supplying answers to queries, including typical questions such as name, address, age, gender; etc. as well as sponsor/vendor supplied specialized survey queries. For purposes of receiving "time-shifted" help, as explained below, the customer can be requested to enter an Electronic mail address during registration as well. At block 6, the customer provides answers to the questions, wherein, at block 11, the IES collects the information and compiles a database profile for this customer, forwards the profile to the sponsor, and activates a timer or starts a calendar to time the customer's Internet on-line help access.

Col. 4, lines 23-39 (emphasis added).

However, as argued above, Toader relates to registering a customer, not a merchant. Furthermore, Toader does not disclose or suggest registering a merchant-preferred category of customer from which to receive responses. Even without the "merchant-" prefix, it is clear that Toader could not satisfy the limitation, since the phrase "category of customers from which to receive responses" would not make sense in Toader's customer registration process. How could a customer-specified

address be used to determine “a category of customers from which to receive responses?” The context clearly speaks to merchant-preferred categories, and the current amendments make this explicit.

As amended, claim 32 recites registering a merchant-preferred category of customers comprises registering a category of customers from a particular geographic area. In other words, a merchant may set a geographic area restriction for receiving customer responses. This may be advantageous, for example, where the merchant is in the service industry and cannot feasibly provide services to customers outside of a particular geographic boundary. None of the cited references disclose or suggest registering merchant-preferred geographic restrictions.

Likewise, claim 33 recites registering a merchant-preferred category of customers comprising customers determined to be frequent shoppers of a particular product. The Examiner takes Official Notice that it is allegedly “well known to monitor a shopper’s trends to determine what products are frequently purchased to customize or target advertisements relating to that product or other products closely related to the products.” The applicant respectfully traverses this Official Notice with respect to how it is being applied in the present case. Making a customer’s frequent shopper status a precondition to a merchant receiving a response is not well known in the art. Accordingly, the applicant respectfully requests that the Examiner provide a reference in support of the rejection.

10. Cited References Do Not Disclose Claimed Audio Indicator Recited in Claims 34 and 36

The Examiner apparently agrees that "the combination of Levitan, Toader, and Kikinis fails to disclose the claimed audio indicator." However, the Examiner takes Official Notice that "alerting or indication by audio is a well known means for quickly alerting a user or getting a user's attention." Office Action, page 7.

Claims 34 and 36 recite "displaying an indicator in connection with the interactive advertisement to indicate that the advertisement is interactive ... wherein the indicator comprises an audio indicator." While use of audio indicators in other context may be known in the art, the use of an audio indicator to indicate whether an advertisement within a broadcast segment is interactive is not well known. Accordingly, the applicant respectfully traverses the Official Notice and requests that the Examiner provide a reference in support of the rejection.

Conclusion

In view of the foregoing, the applicant respectfully submits that all claims discussed above are in condition for allowance. The remaining claims depend from their respective independent claims and are likewise believed to be allowable by virtue of that dependency. Early allowance of all pending claims herein is respectfully requested. If any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the telephone number provided below.